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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,007	10/15/2003	Bernard Gilder	00216-644002	4410
26161	7590	07/02/2004	EXAMINER DEXTER, CLARK F	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,007	Applicant(s) GILDER, BERNARD	
	Examiner Clark F. Dexter	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/852,904.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I (claims 1-8, 14 and 15) in the reply filed on May 21, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Additionally, claims 21-25 have been added by applicant. However, it is respectfully submitted that these claims comprise Group III, combination claims directed to the combination that includes the subcombinations of Groups I and II. Group III has the following relationship as briefly described below:

Invention III is related to inventions I and II as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed as evidenced by the separate claiming of each of the subcombinations. Each subcombination has separate utility such as without the other subcombination.

2. Claims 9-13 and 21-25 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/852,904, filed on May 9, 2001.

Information Disclosure Statement

4. The information disclosure statement filed on October 15, 2003 has been received and the references listed thereon have been considered.

Claim Rejections - 35 USC § 112

5. Claims 1-8, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3, the recitation "an upper edge" is vague and indefinite as to what disclosed structure it refers, and it seems that "edge" should be changed to --surface-- or the like (based on the specification); in line 4, the recitation "during shaving between the blades and the lubricating element" is vague and indefinite as to what is being set forth, and it seems that "between the blades and the lubricating element" should be deleted and re-inserted in line 3 after "disposed".

In claim 2, line 2, "a plurality of channels" is vague as to how it relates to the channel(s) of claim 1, and it seems that --the-- or --said-- should be inserted before "channels".

In claim 15, line 3, "the skin contacting edge surface" lacks antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ortiz, pn 5,689,883.

Ortiz discloses a blade unit with every structural limitation of the claimed invention including a lubricating element (e.g., 21); a backstop (e.g., the land/channel portions of 16 that extend between the blades and the lubricating element as best viewed in Figs. 4) having an upper edge disposed to contact the skin during shaving (e.g., see Fig. 4), wherein the skin contacting edge of the backstop is interrupted by one or more channels (e.g., see Fig. 1, 2).

8. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferraro, pn 4,697,342.

Ferraro discloses a blade unit (e.g., in Figure 1) with every structural limitation of the claimed invention including a lubricating element (e.g., 20); a backstop (e.g., formed by the structure including 12a, 12b and 12c) having an upper edge disposed to contact the skin during shaving, wherein the skin contacting edge of the backstop is interrupted by one or more channels (e.g., between 12a, 12b and 12c).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 4, 6-8, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferraro, pn 4,697,342.

Regarding claims 3, 4, 6-8 and 14, Ferraro discloses blade unit with almost every structural limitation of the claimed invention but lacks (a) the specific sizes as set forth in claims 3, 6 and 7, and (b) backstop being defined by elastomeric material.

Regarding (a), to make the subject features of the claimed sizes would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one of ordinary skill in the art.

Regarding (b), the Examiner takes Official notice that it is old and well known in the art to make various razor elements from elastomeric material to attain well known and desired characteristics such as softer feel, more resilient contact, etc. Therefore, it would have been obvious to one having ordinary skill in the art to make the various parts of the blade unit, including the backstop, from elastomeric material for the well known benefits including those described above.

Regarding claim 15, the Examiner takes Official notice that it is old and well known in the art to arrange the lubricating strip at the front of the razor rather than at the

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rear of the razor for well known benefits including applying lubricant to the skin before the shaving action. Therefore, it would have been obvious to one having ordinary skill in the art in trying to attain the known shaving action to invert the structure shown in Figure 1 such that the lubricating strip is in front of the blades for the well known benefits including those described above.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
June 25, 2004